

Application No. 10/613002  
Reply to Office Action of April 20, 2006

Docket No.: 05579-00304-US

### REMARKS

Applicant respectfully requests reconsideration in view of the amendment and following remarks. The undersign has corrected the typographical error with respect to formula (I) and in the definition of  $R^3$  and  $R^4$  in particular,  $H_5C_6$ -substituted  $C_1$ - $C_4$  alkyl has been corrected. In addition, the applicant has defined the substituents of A in claim 1 from col. 1, lines 23-26 of the issued patent.

Claims 1-5 and 7-15 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents of ring A, does not reasonably provide enablement for all substituents which are possibly put on ring A. Claims 1-5 and 7-15 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the teachings of Suzuki et al. JP 60-015460 (Suzuki), Bennett et al. GB 1582743 which appears to be an equivalent to DE 2818653 (Bennett) cited by the patent under reissue at column 1, lines 49-51 as teaching the instantly claimed component II, and GB Altermatt et al. 2030169 (Altermatt). The applicant respectfully traverses these rejections.

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The applicant thank the Examiner for the opportunity to interview with him on July 27, 2006. The applicant discussed correcting the typographical error with formula I. The applicant also discussed amending claim 1 to include the substituents at page 1, lines 23-26 of the patent. The applicant further discussed submitting evidence offer "Chem. Engr. Product Handbook" already of record. The applicant has enclosed this evidence. The Examiner stated that he believed he still had a prima facie case of obviousness with the prior art for the reasons stated on the record.

**Defective Oath And 35 U.S.C. 112, First Paragraph Rejection**

Claims 1-5 and 7-15 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The applicant has corrected the obvious typographical errors with respect to formula (I) and the definition of  $R^3$  and  $R^4$  in particular,  $H_3C_6$ -substituted  $C_1$ - $C_4$  alkyl. The applicant believes that this rejection should be withdrawn

**35 U.S.C. 112, First Paragraph Rejection**

Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents of ring A, does not reasonably provide enablement for all substituents which are possibly put on ring A. The applicant has defined the substituents on ring A. For the above reasons, this rejection should be withdrawn.

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**35 U.S.C 251 Rejection**

Claims 1-5 and 7-15 are rejected under 35 U.S.C 251 as being broadened in a reissue application filed outside the two year statutory period. The applicant has corrected the formula (I) and the application is clearly a narrowing reissue and not a broadening reissue. For the above reasons, this rejection should be withdrawn.

**35 U.S.C. 103(a) Rejection**

Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the teachings of Suzuki, Bennett and Altermatt. The applicant does not dispute that the dyes of formula I and II are taught by Suzuki and Bennett. However, there is no teaching to use these dyes in combination.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters **without any direction** as to the particular one selection of the reference **without proper motivation**. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious **unless the prior art suggested the desirability of such modification** (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469,473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35

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U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Suzuki, Bennett and Altermatt. For the above reasons, this rejection should be withdrawn.

Assuming arguendo that the Examiner has made a prima facie case of obviousness, the applicant has enclosed a 1.132 Declaration which the applicant believes establishes unexpected superior results. According to the applicant's opinion the closest prior art is the Chemical Engineering Product Handbook which discloses mixtures of the applicant's formula (I) and the applicant's original formula (II) and an additional dyestuff. The applicant has shown the superiority of the mixtures of the restricted claim over mixtures with a dye of formula (II) wherein R<sup>3</sup> and R<sup>4</sup> are both C<sub>2</sub>H<sub>4</sub>OCOCH<sub>3</sub>, (as described in the Handbook) the applicant made comparisons without the additional dyestuff of the Handbook.

As stated at the bottom of page 5 to the top of page 6 of the Declaration,

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The tests show that the dyeings obtained with the inventive dye mixtures A and B and D and E, respectively, do not differ or differ only little from the standard. With other words they are not at all or only little sensitive to change of pH value. In contrast to this, the deviation obtained with dye mixture C and F, respectively, according to prior art at pH 7.5 is considerable. These dyeings are thus sensitive to change of pH value to a very big extent.

For the above reasons, this rejection should be withdrawn. In view of the above amendment, applicant believes the pending application is in condition for allowance.

A one month extension has been filed. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05579-00304-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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Enclosure: One month Extension  
132 Declaration